

Serial No.: 09/662,601

REMARKS

Claims 1-11 are pending in the application. Claim 1 has been amended herein, and claim 11 has been added. Favorable reconsideration of the application, as amended, is respectfully requested.

I. ALLOWABLE SUBJECT MATTER

Applicants note with appreciation the indicated conditional allowability of claims 2, 4, 6 and 10. These claims will be in condition for allowance upon being amended to independent form and to address any indefiniteness issues.

II. REJECTION OF CLAIMS 1-10 UNDER 35 USC §112, 2nd ¶

Claims 1-10 stand rejected under 35 USC §112, second paragraph, as being indefinite. Withdrawal of the rejection is respectfully requested for at least the following reasons.

The Examiner indicates that the "other modes" in Claim 1 and throughout the claims are indefinite. Specifically, the Examiner contends that other than a fax mode there are no other modes specifically set forth.

Applicants initially submit that it is not necessary to define specifically in the claims the particular "other modes" such as printing and copying. Applicants further submit that the interpretation of such "other modes" is not limited to printing and copying, but rather are exemplified by such. The claims are intended to be given their broadest reasonable interpretation in light of the specification. A person having ordinary skill in the art would recognize that other modes in the context of a complex image processing apparatus as described in the specification would include, but not be limited to, printing and copying.

Nevertheless, applicants have amended claim 1 in order to provide more context to the term "other modes". Specifically, applicants have amended claim 1 to refer to "other modes each involving recording image information on a recording medium". Thus, it is clear that the other modes pertain to recording image information on a recording medium. This would include printing and copying. Also, this would include a

Serial No.: 09/662,601

scanning operation can be construed as recording image information on a recording medium in the form of a memory.

Applicants respectfully submit that claim 1, as amended, is not indefinite as it is clear that the "other modes" refer to modes involving recording image information on a recording medium. Such other modes of operation for a complex image processing apparatus are readily understood by those having ordinary skill in the art.

Applicants further respectfully submit that such amendments to claim 1 are not made for purposes of patentability. Rather, such amendments are made merely to provide context to what is meant by "other modes". Applicants are entitled to a full range of equivalents with respect to such feature.

For at least the above reasons, withdrawal of the rejection is respectfully requested.

III. REJECTION OF CLAIMS 1, 3, 5 AND 7-9 UNDER 35 USC §102(b)

Claims 1, 3, 5 and 7-9 stand rejected under 35 USC §102(b) based on *Kato et al.* Applicants respectfully request withdrawal of this rejection for at least the following reasons.

Serial No.: 09/662,601

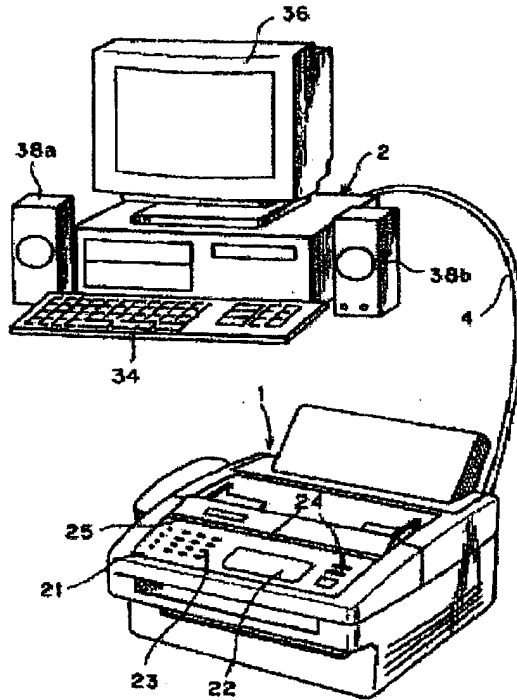


Fig. 1

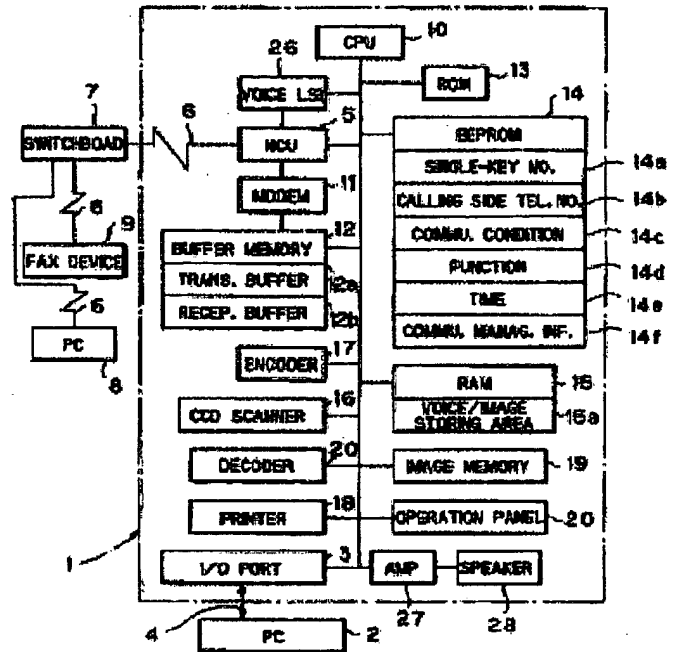


Fig. 2

Kato et al. relates to a system including a facsimile machine 1 and a personal computer 2. (See, e.g., Figs. 1 and 2, reproduced above). The facsimile machine 1 includes internal memory 15 and 19 used for storing image information received as a facsimile. The personal computer 2 includes a hard drive 39 (Fig. 3) which itself may be used to store facsimile information. (Col. 8, lns. 7-15). As is described in *Kato et al.*, when the storage capacity of the memory within the facsimile machine 1 is reduced to less than a predetermined minimum in the process of a storing operation and the entire image data cannot be stored in the facsimile memory, then the remaining part of the image data is sent to the personal computer 2 and stored in its associated hard disk 39. (See, e.g., Abstract).

Claim 1 recites a memory control means for performing control in the facsimile mode such that image information stored in the memory for facsimile is transferred to

Serial No.: 09/662,601

either or both of the memories for the other modes in the case where predetermined conditions are satisfied. Thus, image information which has been stored in the facsimile memory is transferred from the facsimile memory to either or both of the other memories (e.g., copy memory or printer memory) in the case where predetermined conditions are satisfied.

Kato et al. describes a control means having a function to instruct the personal computer 2 to store the whole or a part of the incoming data in the storage device 39 of the personal computer 2 when the residual storage capacity of the memory in the facsimile machine is or has become smaller than a predetermined minimum. (Col. 8, Ins. 26-36). In other words, once the facsimile memory 15/19 in *Kato et al.* is filled to a predetermined amount, the incoming data is redirected to the hard drive 39 of the personal computer 2. This redirecting of the incoming data does not constitute transferring "image information stored in the memory for facsimile" to either or both of the memories for the other modes as recited in Claim 1.

Such operation is further evidenced by Fig. 4 of *Kato et al.* (reproduced herein). Specifically, it is noted that image information is not stored in the fax memory (Steps S4/S12) unless it is determined that the fax memory is not full (Steps S3/S11). In the event the fax memory is full, the image information is directed to the PC memory (Step S8). Thus, there is no "image information stored in the memory for facsimile [which] is transferred to either or both of the memories for the other modes" as recited in claim 1.

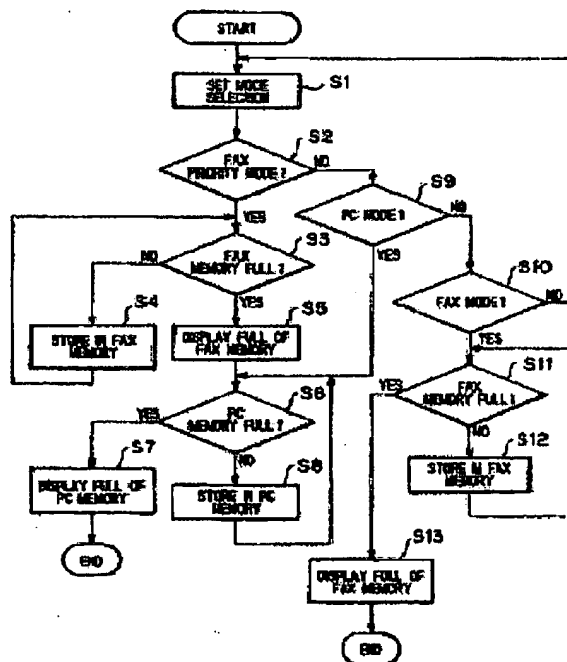


Fig. 4

Serial No.: 09/662,601

Furthermore, the Examiner states that the "mode switching means" of claim 1 corresponds to the switchboard 7 or PC 8 of *Kato et al.* (O.A., p. 3). Referring to Fig. 2 of *Kato et al.*, however, the switchboard 7 is switching equipment for the facsimile machine 1 to communicate with another facsimile machine 9 or PC 8. The facsimile 9 or PC 8 simply relate to a receiving side, via a telephone line, relative to the facsimile machine 1 in *Kato et al.* (Col. 5, Ins. 43-48).

In *Kato et al.*, the PC 8 is merely functioning as a facsimile receiving apparatus according to the switching of the switchboard 7. Hence, neither the switchboard 7 nor the PC 8 function in any way as the memory control means in claim 1 which performs control such that image information stored in the memory for facsimile is transferred to either or both of the memories for the other modes in the case where predetermined conditions are satisfied.

Moreover, the Examiner states that the memory control means of claim 1 corresponds to the ROM 13 of *Kato et al.* based on the description at Col. 10, lines 6-21. However, all that is described in *Kato et al.* is that the data is stored in the fax memory or in the PC memory according to the residual storage capacity. There is no teaching or suggestion in *Kato et al.* of the ROM 13 performing control such that image information stored in the memory for facsimile is transferred to either or both of the memories for the other modes in the case where predetermined conditions are satisfied as recited in claim 1.

Applicants therefore respectfully submit that *Kato et al.* fails to teach or suggest the invention as recited in claim 1 or the claims which depend therefrom. Withdrawal of the rejection is respectfully requested.

IV. NEW CLAIM 11

Applicants further note that the present invention contemplates a "stand-alone" type device which itself is capable of complex image processing in the form of a copier, printer, facsimile, etc. The facsimile machine 1 in *Kato et al.* does not function as a stand-alone device in the context of providing for the storage of image information in the different modes of memory.

Serial No.: 09/662,601

New claim 13 emphasizes this feature of the invention.

V. CONCLUSION

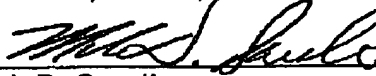
Accordingly, all claims 1-11 are believed to be allowable and the application is believed to be in condition for allowance. A prompt action to such end is earnestly solicited.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

Should a petition for an extension of time be necessary for the timely reply to the outstanding Office Action (or if such a petition has been made and an additional extension is necessary), petition is hereby made and the Commissioner is authorized to charge any fees (including additional claim fees) to Deposit Account No. 18-0988.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP


 Mark D. Saralino
 Reg. No. 34,243

DATE: September 9, 2004

The Keith Building
 1621 Euclid Avenue
 Nineteenth Floor
 Cleveland, Ohio 44115
 (216) 621-1113

C:\Documents and Settings\Mark\My Documents\Gen\Salk\salkp113.amd0.wpd